

**REMARKS**

Claims 1-4 have been allowed.

**35 U.S.C. § 112, Second Paragraph Rejection**

Claims 5-6 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 5 has been amended to overcome the rejection under 35 U.S.C. § 112, second paragraph. Amended claim 5 conforms to the teachings of the specification of the present invention. *See* Specification column 2, lines 59-65. Applicant respectfully requests that the Examiner enter the amendment and allow independent claim 5 and claim 6, which is dependent therefrom, for issue.

**35 U.S.C. § 102(b) Anticipation Rejection**

Claims 7-32 are rejected under 35 U.S.C. § 102(b) as being anticipated by Tateno (U.S. Pat. 4,733,459). Applicant respectfully traverses this rejection.

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” Verdegaal Brothers Inc. v. Union Oil Company of California, 2 USPQ2d 1051, 1053 (1987). For each and every element to be shown in a single piece of prior art “every element of the claimed invention must be literally present, arranged as in the claim.” Richardson v. Suzuki Motor Co. Ltd., 9 USPQ2d 1913, 1920 (1989). The Tateno patent fails to expressly or inherently describe a “testing apparatus” or a “separating apparatus” as claimed with respect to the current invention, thus failing to provide a basis upon which a proper rejection for anticipation under 35 U.S.C. § 102(b) may stand. *See*, MPEP § 2131.

The “testing apparatus” recited in independent claims 7 and 10 of the present invention comprises “a holding station, a first position, and a second position,” “positioned to receive

the untested integrated circuits from the receiving apparatus and test the integrated circuits.” The Tateno patent fails to disclose an apparatus including the recited elements. The Examiner maintains that the hand 44 of the Tateno patent anticipates the “testing apparatus” of the present application. However, the hand 44 merely moves an untested integrated circuit from one position to another without performing any tests on the integrated circuit. The hand 44 of Tateno is incapable of testing integrated circuits and the reference fails to expressly or inherently disclose or even suggest a “testing apparatus” which is in any way similar to that of the present invention. Such failure precludes an anticipation rejection under 35 U.S.C. § 102(b) of claims 7 and 10. *See Verdegaal Brothers Inc.*, 2 USPQ2d at 1053. In light of this fact, the Applicant respectfully requests the Examiner to withdraw the anticipation rejection and allow independent claims 7 and 10 and all dependent claims therefrom (claims 8-9 and 11-12).

Likewise, independent claims 25 and 29 recite a “testing apparatus” which identifies “first and second test conditions of an integrated circuit while in said second position.” The hand 44 of the Tateno patent inserts integrated circuits into a circuit board at the second position. It lacks the capability to test integrated circuits, thereby failing to anticipate the “testing apparatus” of claims 25 and 29 of the present invention. Tateno’s failure to expressly illustrate or disclose every element of the “testing apparatus” of the present invention bars an anticipation rejection under 35 U.S.C. § 102(b). The Applicant respectfully requests the Examiner to allow independent claims 25 and 29 and claims 26 and 30 respectively depending therefrom.

For the same reasons stated above, the 35 U.S.C. § 102(b) anticipation rejection of the independent method claims 13, 16, 19, 22, 27 and 31 should be withdrawn. Tateno’s failure to disclose, *inter alia*, method steps of “receiving the integrated at the testing apparatus while in the first position,” “moving the testing apparatus to the second position,” “testing the integrated circuit” in the second position and “moving the testing apparatus to the first position,” as recited in Applicant’s claims precludes an anticipation rejection of method claims

13, 16, 19, 22, 27 and 31 and all dependent claims respectively following therefrom. *See Richardson*, 9 USPQ2d at 1920.

In addition, the anticipation rejection should be withdrawn because Tateno fails to disclose a “separating apparatus” having a “defective integrated circuit track...and a non-defective integrated circuit track” as recited in the apparatus claims of the present invention, or a “method of testing an integrated circuit” which involves “separating the defective and non-defective integrated circuits,” as recited in the method claims of the present invention.

The elevator portion 60 of the Tateno patent is likened by the Examiner to the “separating apparatus” of the present invention. Applicant believes that this is in error. The elevator portion 60 of the Tateno patent receives printed circuit boards, to which a plurality of integrated circuits are secured, from the electronic parts insertion apparatus. The elevator portion 60 is incapable of separating defective and non-defective chips from the circuit boards it receives. The elevator portion 60 of the Tateno patent is also void of any tracks upon which defective and non-defective integrated circuit chips could be separated even if the elevator portion 60 were capable of separating defective integrated circuits from those that are non-defective. The failure of Tateno to disclose a “separating apparatus” having a “defective integrated circuit track...and a non-defective integrated circuit track” precludes an anticipation rejection under 35 U.S.C. § 102(b) because each and every element of the present invention has not been disclosed. *See Richardson*, 9 USPQ2d at 1920. Therefore, Applicant respectfully requests that the Examiner withdraw the anticipation rejection as to independent claims 7, 10, 25 and 29, and to dependent claims 8, 9, 11, 12, 26 and 30 following respectively therefrom.

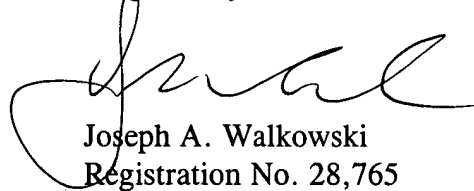
Likewise, independent method claims 13, 16, 19, 22, 27 and 31 recite a step of separating defective integrated circuits from non-defective integrated circuits which is not disclosed by Tateno. As with the observations above, the inability of the elevator portion 60 of the Tateno invention to separate the defective and non-defective integrated circuits precludes an anticipation rejection under 35 U.S.C. § 102(b) as to the method claims of the present

invention. The Applicant respectfully requests that the Examiner withdraw the anticipation rejection as to independent claims 13, 16, 19, 22, 27 and 31 and dependent claims 14, 15, 17, 18, 20, 21, 23, 24 and 32, which follow respectively therefrom.

**CONCLUSION**

The Applicant respectfully requests that the Examiner allow the amendment of claim 5 in order to place claims 5 and 6 in condition for allowance. The Applicant further requests that the Examiner withdraw the 35 U.S.C. § 102(b) anticipation rejection and allow claims 7 to 32 because they are now in condition for allowance. Claims 1-32 being in condition for allowance, an indication thereof is respectfully requested.

Respectfully Submitted,



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March 11, 1999

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